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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,196	09/01/2004	Kuci-Jung Lee	WNCP0003USA4	5195
27765	7590	06/15/2006	EXAMINER	
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION			KING, JUSTIN	
P.O. BOX 506			ART UNIT	
MERRIFIELD, VA 22116			PAPER NUMBER	
			2111	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,196

Applicant(s)

LEE, KUEI-JUNG

Examiner

Justin I. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/1/05, 2/27/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, 7-13, and 18-20 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-2, 6-7, 9-12 of copending Application No. 10/605,455. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a peripheral device or a method of driving a peripheral device comprising of an application module positioned at least partially inside the housing; a storage module positioned inside the housing for storing a device driver of the application module and a firmware that can drive the storage module to simulate an autorun function of an optical disc drive; and a hub controller positioned inside the housing, the hub controller being electrically connected to the application module and the storage module; wherein when the hub controller is electrically connected to the interface port, the electronic device host is capable of retrieving the device driver stored by the storage module and running the device driver to operate the application module.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, 10-17, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee, J Y (KR 2002068004), which is listed on the IDS dated 2/27/2006.

Referring to claims 1 and 19-20: Lee discloses a wireless USB LAN card with a flash memory storing the LAN driver (English Abstract). Lee's wireless USB LAN card is the claimed peripheral device capable of being connected to an interface port on an electronic device host (the computer host). Lee's peripheral device comprises an application module (the wireless LAN card), a storage module (the flash memory), and a hub controller (the USB hub controller according to the USB Specification 2.0 Section 4.8.2.1). Lee's USB wireless LAN card is connecting to the interface port, and then enabling the hub controller for controlling data transmission among the application module, the storage module, and the electronic device host. Lee's flash memory contains the driver to operate the wireless LAN card; which is the claimed enabling the storage module and utilizing the electronic device host for retrieving a device driver of the application module from the storage module through the hub controller, and running the device driver to operate the application module. Hence, the claim is anticipated by Lee.

Referring to claim 2: The incorporated USB Specification discloses the power management over each USB device. The USB Specification discloses that each hub provides the

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current/voltage to the downstream ports (USB Specification, Rev. 2.0, Section 7.2.1); the USB hub's means to control and to provide the voltage to the downstream ports is the claimed power controller electrically connecting to the storage module and the application module for controlling if a predetermined voltage is delivered to the storage module to enable the storage module and controlling if the predetermined voltage is delivered to the application module to enable the application module.

Referring to claims 3 and 7: The USB Specification discloses the power management over each USB device. The USB Specification discloses that each bus-powered hub draws power from the upstream port and provides the current/voltage to the downstream ports (USB Specification, Rev. 2.0, Section 7.2.1), which is the claimed outputting voltage from the device host through the interface port.

Referring to claim 4: As stated above, the USB Specification discloses the power management over each USB device. Lee's means for executing the driver is the claimed firmware.

Referring to claims 5-6: As disclosed in the Specification, it is a norm to detect the driver on the host before asking the user for a driver (Specification, page 3, last 3 lines, page 4, lines 1-6).

Referring to claim 8: The host's port, which connects to Lee's USB device, is the CardBus.

Referring to claim 10: Lee discloses a wireless USB LAN card with a flash memory storing the LAN driver (English Abstract). Lee's wireless USB LAN card is the claimed peripheral device capable of being connected to an interface port on an electronic device host

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(the computer host). Lee's peripheral device comprises an application module (the wireless LAN card), a storage module (the flash memory), and a hub controller (the USB hub controller according to the USB Specification 2.0 Section 4.8.2.1). Lee's USB wireless LAN card is connecting to the interface port, and then enabling the hub controller for controlling data transmission among the application module, the storage module, and the electronic device host. Lee's flash memory contains the driver to operate the wireless LAN card, which is the claimed enabling the storage module and utilizing the electronic device host for retrieving a device driver of the application module from the storage module through the hub controller, and running the device driver to operate the application module. Hence, the claim is anticipated by Lee.

Referring to claim 11: The incorporated USB Specification discloses the power management over each USB device. The USB Specification discloses that each hub provides the current/voltage to the downstream ports (USB Specification, Rev. 2.0, Section 7.2.1); the USB hub's means to control and to provide the voltage to the downstream ports is the claimed power controller electrically connecting to the storage module and the application module for controlling if a predetermined voltage is delivered to the storage module to enable the storage module and controlling if the predetermined voltage is delivered to the application module to enable the application module.

Referring to claim 12: The USB Specification discloses the power management over each USB device. The USB Specification discloses that each bus-powered hub draws power from the upstream port and provides the current/voltage to the downstream ports (USB Specification, Rev. 2.0, Section 7.2.1), which is the claimed outputting voltage from the device host through the interface port.

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Referring to claim 13: The USB Specification discloses the power management over each USB device. The USB Specification discloses that each bus-powered hub draws power from the upstream port and provides the current/voltage to the downstream ports (USB Specification, Rev. 2.0, Section 7.2.1), which is the claimed outputting voltage from the device host through the interface port.

Referring to claim 14: As stated above, the USB Specification discloses the power management over each USB device. Lee's means for executing the driver is the claimed firmware.

Referring to claims 15-16: As disclosed in the Specification, it is a norm to detect the driver on the host before asking the user for a driver (Specification, page 3, last 3 lines, page 4, lines 1-6).

Referring to claim 17: The host's port, which connects to Lee's USB device, is the CardBus.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the Lee and the admitted prior art.

Referring to claims 9 and 18: Lee does not explicitly disclose 1394. The admitted prior art discloses that the IEEE 1394 is a well-known protocol for supporting plug & play (Specification, page 1, last paragraph). Hence, it would have been obvious to one having ordinary skill in the computer art at the time Applicant made the invention to adapt the IEEE 1394 onto Lee because IEEE 1394 enables one to simplify a hardware installation via the plug & play.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Korean Public Publication KR 2004059393 to Mun G H: Mun discloses a USB module combining a wireless LAN and a flash memory.

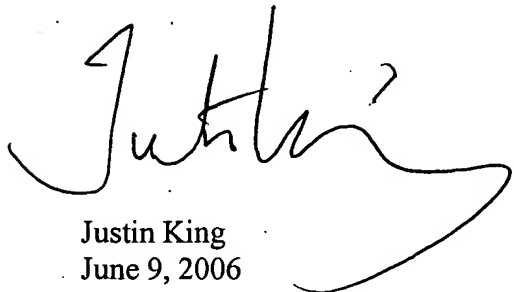
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin I. King whose telephone number is 571-272-3628. The examiner can normally be reached on Monday through Friday, 9:00 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 571-272-3632 or on the central telephone number, (571) 272-2100. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lastly, paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions as of June 2004. Paper copies of foreign patents and non-patent literature will continue to be included with office actions. These cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. patent or patent application publications will not be granted.



Justin King
June 9, 2006



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